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10/698,424	11/03/2003	David W. Johnson	CALW-004/01US 306562-2009	1511
58349	7590	03/25/2011	EXAMINER	
COOLEY LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ROBINSON, KEITH O NEAL	
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			1638	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/698,424

**Applicant(s)**

JOHNSON ET AL.

**Examiner**

KEITH ROBINSON

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4, 6-19, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-19, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 10/6/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's cancellation of claims 1, 5 and 20-29 and amendment of claims 15, 17, 19, 30 and 31, filed October 6, 2010, have been received and entered in full.

Claims 2-4, 6-19, 30 and 31 are under examination.

### ***Response to Arguments***

Applicant's arguments, see page 15, paragraph I of 'Remarks' filed October 6, 2010, with regard to the 'Specification objection' on page 2 of the Office Action mailed May 6, 2010 has been fully considered and deemed persuasive; thus, the objection has been withdrawn.

Applicant's arguments, see page 15, paragraph III to page 21 of 'Remarks' filed October 6, 2010, with regard to the 35 USC § 112, first paragraph enablement rejection on pages 6-11 of the Office Action mailed May 6, 2010 has been fully considered and deemed persuasive; thus, the rejection has been withdrawn.

Applicant's arguments, see page 22, paragraph IV to page 23, 1<sup>st</sup> paragraph of 'Remarks' and the "Johnson Declaration", both filed October 6, 2010, with regard to the 35 USC § 102/103 rejection on pages 11-14 of the Office Action mailed May 6, 2010 has been full considered and deemed persuasive; thus, the rejection has been withdrawn.

***Claim Objections***

Claim 15 is objected to because of the following informalities: The claim has been improperly amended because apparently deleted material was never struckthrough. Original claim 15, filed September 26, 2005 recited "and" between parts (a) and (b). However, the amendment of June 21, 2006 did not recite "and" between parts (a) and (b), but did not strikethrough the previous "and". See 37 CFR 1.121(c).

It appears that this is a typographical error and therefore the claims have been examined on the merits in the interest of compact prosecution. Applicant is invited to amend claim 15 to re-introduce the "and" between parts (a) and (b) in claim 15 (as recited in claim 30).

If Applicant intends to delete the "and" between parts (a) and (b) in claim 15, then Applicant should submit an amendment which recites and strikes through that "and". Such an amendment would necessitate an art rejection over claim 15 based on the standability trait alone and also for any dependent claims which only deal with standability; as was recently done in copending applicant 11/925,041.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, first paragraph – Written Description***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-4, 6-19, 30 and 31 (newly amended) remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims read on any *Medicago sativa* alfalfa variety comprising 'French' type alfalfa germplasm, wherein said variety has **8% or greater faster recovery after spring green-up or after harvest** compared to an adapted check variety selected from the group consisting of 'Wintergold' and 'Hybri-Force 400' and **15% or greater more erect stems at late bloom** compared to an adapted check variety selected from the group consisting of 'WL325HQ' and 'WL319HQ'.

The specification has not identified which conserved germplasm is associated with the faster recovery after spring green-up or after harvest trait. The specification discloses four exemplified varieties by crossing over 1000 undisclosed and uncharacterized "French lines" (see, for example, page 25, lines 3 and 15; page 29, lines 13-16 and page 30, line 3; page 35, lines 7 and 16; page 40, lines 3-12).

The specification, see, for example, page 16, Table 4, discloses that the alfalfa varieties Daisy, Diane, Europe (also known as Europa), Marshall and Mercedes; all previously identified as comprising "French-type germplasm"(see, for example, page 19, last paragraph to page 20, line 3 of 'Remarks' filed October 6, 2010), including at least one variety with 100% French-type germplasm (Europa, see page 26, Exhibit B of

'Remarks' filed October 6, 2010); have poorer recovery than the claimed control/check varieties when grown in North America.

Thus, the mere presence of "French-type germplasm" is not correlated with faster recovery after spring green-up. In addition, a representative number of species of plants with the claimed characteristics has not been shown.

In addition, the specification has not identified which conserved germplasm is associated with the more erect stems at late bloom trait (i.e., standability). With regard to standability and French-type germplasm, the mere presence of French-type germplasm does not appear to be correlated with *significantly* higher standability when compared to the instantly claimed check varieties WL 325HQ and WL 319HQ. Page 20, second full paragraph of 'Remarks' filed June 21, 2006 states that Winter Gold has 47% Flemish (French) cytoplasm. Page 21 of that response, top paragraph, states that the variety 54V54 has greater than 27% Flemish cytoplasm. However, instant Tables 7a, 7b and 7d on pages 19, 20 and 22 show that each of these varieties has only *slightly* higher standability than the instantly claimed check varieties. Furthermore, a representative number of species of plants with the claimed characteristics has not been shown.

### ***Response to Arguments***

Applicant argues that the amendment of claim 15 to recite the limitation that the claimed alfalfa varieties comprise "French-type alfalfa germplasm" provides adequate description to overcome the rejection (see page 15, paragraph II of 'Remarks' filed October 6, 2010).

This is not persuasive. As stated above, the specification has not identified which conserved germplasm is associated with the claimed characteristics and the specification does not provide evidence that the mere presence of "French-type germplasm" is not correlated with the claimed characteristics.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Barnes et al (Alfalfa germplasm in the United States: Genetic vulnerability, use, improvement and maintenance. USDA Tech Bull 1571, 1977).

The claim reads on a seed produced by crossing the pollen of the plant of claim 15 with any other plant, thus, resulting in a plant with at best 50% of the germplasm of the plant of claim 15. Therefore, the seed of claim 18 (or any plant produced from said seed) would not retain the standability or faster recovery characteristics of the original plant and thus would be indistinguishable over Europe.

Barnes et al teach alfalfa variety 'Europa' (also known as 'Europe') is a Flemish type (see, for example page 6, Table 1); thus, as evidenced by the specification, Europa is a 'French' type alfalfa. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977), which teaches that where the prior art product seems to be identical to the claimed product,

except that the prior art is silent as to a particularly claimed characteristic or property, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention.

The rejection can be overcome by amending claim 18 as follows:

---18 (Currently amended) A seed of an alfalfa plant pollinated by the pollen of claim 17 or a regenerable part of said seed, wherein a plant produced from said seed or regenerable part of said seed has 8% or greater faster recovery after spring green-up or after harvest compared to an adapted check variety grown in the same field growing conditions, wherein the adapted check variety is selected from the group consisting of 'WinterGold' and 'Hybri-Force 400'; and 15% or greater more erect stems at late (i.e. 75%) bloom compared to an adapted check variety grown under the same environmental conditions, wherein the adapted check variety is selected from the group consisting of 'WL325HQ' and 'WL319HQ'.---

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated



by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(A) **Claims 6-19 and 31** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1 and 2** of U.S. Patent No. **7,288,698**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of U.S. Patent 7,288,698 are a species of the genus of alfalfa plants claimed in the instant application. The claims are coextensive.

Claims 1-2 of the patent are drawn to a genus comprising two alfalfa plant varieties which exhibit 15% or greater more erect stems at late bloom, and which are inherently comprised of French/Flemish-type cytoplasm.

(B) **Claims 2-4, 15-19 and 31** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1 and 2** of U.S. Patent No. **7,288,697**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of U.S. Patent 7,288,697 are species of the genus of alfalfa plants claimed in the instant application. The claims are coextensive.

Claims 1-2 of the patent are drawn to a genus comprising two alfalfa plant varieties which exhibit at least 8% faster recovery after spring green-up or after harvest, which varieties inherently comprise French/Flemish-type cytoplasm.

For the purpose of the two rejections above, the instant claims are interpreted as any alfalfa plant having at least one of the claimed characteristics because instant claim 15, as discussed above, does not currently state that the claimed alfalfa plants has 8% or greater recovery after spring green-up and 15% or greater more erect stems at late bloom (i.e., standability).

(C) **Claims 2-4, 6-19 and 30-31** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-2 of each of** U.S. Patent Nos. **7,288,697 and 7,288,698**. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of patented claims are drawn to particular alfalfa varieties comprising French/Flemish-type

cytoplasm, wherein said varieties inherently exhibit both of the standability and recovery values as the genus of alfalfa plants instantly claimed. The claims are coextensive.

### ***Conclusion***

No claims are allowed.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH O. ROBINSON whose telephone number is (571)272-2918. The examiner can normally be reached Monday – Friday, 8:00 a.m. - 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 1638

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson

/DAVID T FOX/

Primary Examiner, Art Unit 1638